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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/193,833	11/17/1998	MARK GAINY	003838.P001	2499
758	7590	11/13/2003	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			LE, DEBBIE M	
			ART UNIT	PAPER NUMBER
			2177	25

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	Applicant(s)	
09/193,833	HORVATH ET AL.	
Examiner	Art Unit	
DEBBIE M LE	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 22 September 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 4-13 and 17-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 4-13, 17-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

Applicant's argued filed on 9/22/03. Claims 1-3, 14-16 are canceled (there is typographical error in the remark (paper # 24, page 2, line 1. Applicants meant to cancel claims 14-16 instead of 14-17). Claims 4-13, 17-21 are presented for examination.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 4, 6-7, 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Botts et al (US Patent 6, 122,632).

As to claim 4, Botts discloses a electronic message management system comprising:

receiving a first message in an enterprise mail system, said a first message from a first human message sender (col. 5, lines 8-17);

storing said first message in a message database (col. 5, lines 31-33, lines 66-67);

assigning a category entry from a category database to said first message, said category entry containing information for handling particular incoming message (col. 5, lines 66-67, col. 6, line 1, lines 14-22, col. 9, lines 39-42);

delivering said first message to a first enterprise mail system and providing a template response message to said first enterprise mail system user using information said category entry, said template response message including a set of message recipients defined in said category entry (fig. 15, col. 9, lines 42-45, col. 10, lines 10-60).

As to claim 6, Botts discloses assigning a category entry from a category database to said first message is performed by said enterprise mail system user (col. 5, lines 38-40).

As to claim 7, Botts discloses wherein providing a template response message further comprises providing a set of default message body sections for said template response message (fig. 17, 25, col. 10, lines 8-15).

As to claim 12, Botts discloses wherein said message database comprises a relational database (col. 6, lines 1-12).

As to claim 13, Botts discloses wherein one of said recipients comprises said human message sender (col. 8, lines 35-63).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Botts et al (U.S Patent 6,122,632) in view of Billmers et al (US Patent 6,226,630).

As per claim 5, Botts does not explicitly teach assigning a category entry from a category database to said first message is performed by a rule processor. However, Billmers teaches using message filtering rules to classify and categorize a message (abstract, fig. 7, col. 6, lines 1-18). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Botts with Angotti to implement the step of assigning a category entry from a category database to a first message is performed by a rule processor because it provides automatically processing a incoming message without an intermediate manual step, in other word, without the intervention of a human operator.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botts et al (U.S Patent 6,122,632) in view of Gormley et al (U.S Patent 5,806,057).

As to claims 8-11, Botts do not explicitly teach one set of default message body sections comprising: a salutation, a body header, a closing, and a footer. However, Gormley's does teach those features (fig. 8, 17, 19, 25, 24b, 28, 33, # 486, 467, 34a, col. 16, lines 64-65, col. 17, lines 56-67, col. 25 & 26). One of ordinary skill in the art is motivated to modify Botts with Gormley to generate a response with a predefined form in order to speed up the response time.

Claims 17-21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Billmers et al (US Patent 6,226,630) in view of Angotti (US Patent 6,182,059).

As per claim 17, Billmers teaches a system comprising:

Receiving an electronic mail message (fig. 2, #48, # 56), analyzing the contents of the received electronic messages, responsive to the analysis of the contents of the

messages, associating the electronic mail message with a message category (col. 4, lines 8-25, col. 7, lines 9-24).

Billmers does not explicitly teach automatically generating a skeleton response message to at least one recipient, wherein the recipients are selected responsive to associating the electronic mail message with the message category. However, Angotti teaches this feature at (col. 3, lines 19-20, column 9, lines 14-25, col. 5, lines 37-40). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Billmers with Angotti to allow the system automatically generating response message to at least one recipient in order to reduces the time required and/or provide an appropriate response to the customer inquiries.

Claims 20-21 are rejected by the same rationale as stated in independent claim 17 arguments.

As per claims 18-19, Angotti teaches analysis of the contents of the received electronic mail message is performed automatically and manually (col. 5, lines 37-47).

### ***Response to Arguments***

Applicant's arguments filed on 9/22/03 have been fully considered but they are not persuasive.

Applicants argued that Botts does not teach generating a template response including a set of message recipients defined in said category entry.

In response, the examiner respectfully disagrees. Botts does teach that a template response (interfaces the CSRs to a database containing predefined, standard, responses for frequently asked questions, col. 3, lines 30-32) including a set of message recipients defined in said category entry (allows categorization of all electronic inquiries/messages by client-defined categories, col. 3, lines 41-42) and (E-mail messages are preferably grouped according to the e-mail addresses where the inquiry was sent, col. 8, lines 35-36, by selecting a group, the corresponding electronic messages received, and queued, for that group are retrieved, col. 8, lines 48-49).

Applicants argued that Angotti does not teach automatically generating a skeleton response message to at least one recipient.

In response, the examiner submits that at column 3, line 19 "automatically classify incoming messages" (from who, sender addresses, recipient) and line 20 "automatically obtain responses to the messages" (as automatically generating a skeleton response message to at least one recipient).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

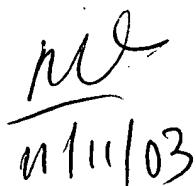
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose phone number is (703) 305-9601 for faster service.

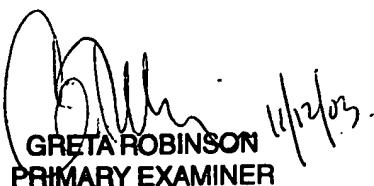
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M LE whose telephone number is 703-308-6409. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
n11/03

DEBBIE M LE  
Examiner  
Art Unit 2177

  
Greta Robinson  
PRIMARY EXAMINER